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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,459	02/04/2004	Hiroshi Takemoto	248348US-3 DIV	1340
22850	7590	04/02/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GOFF II, JOHN L	
			ART UNIT	PAPER NUMBER
			1733	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/02/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/02/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/770,459

Applicant(s)

TAKEMOTO ET AL.

Examiner

John L. Goff

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/237,661.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/5/07 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Art Unit: 1733

The disclosure of the prior-filed application, Application No. 09/237,661, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The subject matter of the current and only claim, claim 1, was first introduced at the time of filing Application No. 09/777,847 as new claim 34. Claim 1 requires “curing said first adhesive and said second adhesive using UV light such that said intermediate member, can move due to shrinkage of at least one of said first adhesive and said second adhesive”. This limitation was not disclosed in Application No. 09/237,661 (there being no discussion in the application of the first or second adhesive shrinking), and thus, as the current claim is directed to subject matter other than that disclosed in Application No. 09/237,661 the current claim is not entitled a priority benefit to Application No. 09/237,661. Claim 1 has the benefit of priority only to Application No. 09/777,847 which was filed 02/07/2001.

Oath/Declaration

4. The declaration submitted 2/4/04 is a copy of that submitted in Application No. 09/237,661, and as this application presents a claim for subject matter not adequately supported or enabled by Application No. 09/237,661 a supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Art Unit: 1733

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification does not describe “curing said first adhesive and said second adhesive using UV light such that said intermediate member can move due to shrinkage of at least one of said first adhesive and said second adhesive”. It is noted the limitation is supported by the originally filed claim, but it is noted supported by Figures 31A-32B as argued by applicant as the drawings are not drawn to scale and there is no indication from the drawings that the intermediate member moves due to shrinkage of at least one of the first or second adhesives, the specification specifically describing curing the adhesive and then moving the intermediate member using a position adjustment mechanism not shown in Figures 31A-32B (Column 23, lines 34-43 and Column 24, lines 9-53). It is suggested that in order to overcome the objection the specification should be amended to describe the limitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

Art Unit: 1733

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al. '784 (U.S. Patent 6,000,784) in view of Ito (JP 58049636 and see also the abstract):

Takemoto et al. '784 is available as prior art under 35 U.S.C. 102(b) as the U.S. filing date of claim 1 is 02/07/2001 (the filing date of priority Application No. 09/777,847) as set forth above, and Takemoto et al. '784 published 12/14/99. Takemoto et al. disclose a method of mounting an ink jet printhead comprising providing a first member (14 of Figure 13) and a chuck (24 of Figure 13) for positioning and fixing the first member, providing a second member (11a-d of Figure 13) and a chuck (27 of Figure 13) for positioning and fixing the second member, providing an intermediate member (13a-13d of Figure 13) between the first and second members, applying a first adhesive (15 of Figure 13) at the interface between the first member and the intermediate member, applying a second adhesive (15 of Figure 13) at the interface between the second member and the intermediate member, and curing the first adhesive and the second adhesive using UV light such that the intermediate member can move due to shrinkage of the first and second adhesives such that after curing the first member is accurately bonded to the second member through the intermediate member (Figures 11-13 and Column 8, lines 46-67 and Column 9, lines 1-67 and Column 10, lines 1-37). Takemoto et al. '784 also teach another embodiment comprising providing a first member (14 of Figure 25) and a chuck (24 of Figure

Art Unit: 1733

25) for positioning and fixing the first member, providing a second member (11d of Figure 25) and a chuck (27 of Figure 25) for positioning and fixing the second member, providing an intermediate member (13a of Figure 25) between the first and second members, applying a first adhesive (15 of Figure 25) at the interface between the first member and the intermediate member, applying a second adhesive (15 of Figure 25) at the interface between the second member and the intermediate member, and curing the first adhesive and the second adhesive using UV light such that the intermediate member can move due to shrinkage of the first and second adhesives such that after curing the first member is accurately bonded to the second member through the intermediate member (Figure 25 and Column 15, lines 36-62 and Column 16, lines 25-45). Takemoto et al. are silent as to the curing using UV light including filtering the light such that the color of the intermediate member is maintained, it being noted the application of UV light in Takemoto et al. to cure the adhesives is through the intermediate member which is transparent (Column 10, lines 20-26). Ito discloses applying UV light to materials including adhesives, coatings, inks, etc. wherein the UV light below 360 nm is filtered and removed before the UV light contacts the materials to prevent the materials from discoloring (See the abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Takemoto et al. a step of filtering the UV light applied through the transparent intermediate member to remove wavelengths below 360 nm as shown by Takemoto et al. to prevent the intermediate member from discoloring and blocking the UV light.

Art Unit: 1733

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al. '015 (U.S. Patent 6,627,015) in view of Ito.

Takemoto et al. '015 is available as prior art under 35 U.S.C. 102(e) as the U.S. filing date of claim 1 is 02/07/2001 (the filing date of priority Application No. 09/777,847) as set forth above, and Takemoto et al. '015 has a U.S. filing date of 3/10/1998. Takemoto et al. '015 discloses the same as Takemoto et al. '784 discussed in full detail above (See Figures 13 and 25 and Column 8, lines 50-67 and Column 9, lines 1-67 and Column 10, lines 1-40 and Column 15, lines 38-64 and Column 16, lines 28-48 of Takemoto et al. '015). Takemoto et al. '015 is combined with Ito in the same manner as Takemoto et al. '784 in view of Ito set forth above.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1733

11. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,627,015 in view of Ito. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of U.S. Patent No. 6,627,015 fully encompasses and discloses all the limitations of claim 1 of the instant Application except for the curing using UV light including filtering the light such that the color of the intermediate member is maintained which is obvious in view of Ito as set forth above, it being noted UV ray curable adhesive applied to adhering surfaces of the intermediate member as set forth in claim 6 is considered applying adhesive to at least two surfaces of the intermediate member, i.e. a first adhesive to a first surface and a second adhesive to a second surface of the intermediate member.

Response to Arguments

12. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

The new claim limitation is addressed above. Applicants arguments to the objection to the specification are addressed above.


Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

Art Unit: 1733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John L. Goff
Patent Examiner
Art Unit 1733